

REMARKS-General

1. The newly drafted independent claim 21 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 21-32 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

2. With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

Response to Rejection of Claims 1-10 under 35USC103

3. The Examiner rejected claims 1-10 as being unpatentable over Kaish et al. (US 5,974,150) in view of Kerns et al. (US 2005/0264001) Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

4. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

5. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Kaish et al. which is qualified as prior art

of the instant invention under 35USC102(b) are obvious in view of Kerns et al. at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

6. The applicant respectfully submits that the differences between the instant invention and Kaish et al. are not obvious in view of Kerns under 35USC103(a), due to the following reasons:

(A) Referring to the newly drafted independent claim 21, the examiner is of the view that it would have been obvious for one having ordinary skill in the art to provide the algorithm of the two dimensional barcode taught in Kerns et al. combined with the fiber image with a serial number taught in Kaish et al. in order to provide an article with several authentication features. The applicant disagrees. Kaish et al. generally discloses an authentication system comprising a medium having a plurality of elements, each element having an irregularity selected from the group consisting of one or more of an irregular spatial arrangement and an irregular characteristics, and having a determinable intrinsic attribute distinct from a two-dimensional chroma-luminance map, a detector, a processor and a recording system (Kaish et al., Col. 28, Claim 1). The attributes of the elements are **polarization** or **dichroic fibers**. Although two-dimensional barcode is also included in the authentication system, it does not work in the same manner as that disclosed in the instant invention. In the instant invention, the encrypted texture label comprises a fiber texture sector having randomly distributed pieces of fiber threads to form a **fiber image**; and a planar bar code sector defining a planar code in the planar bar code sector, wherein the planer code is adapted for storing **information of the fiber image** of the fiber texture sector, and the **serial number** of the object by using a first pre-set algorithm, wherein the fiber texture sector and the planer bar code sector form a **unique anti-forgery representation and a product identification** of the product so as to maximize a difficulty in unauthorized reproduction of the encrypted texture label. This is an unexpected result undisclosed in Kaish et al. and Kerns et al.

(B) Kaish et al. discloses that an authentication of the medium may be authenticated with a statistical tolerance, based on vector mapping if the elements of the medium, **without requiring a complete image** of the medium and elements to be recorded (Kaish et al., Abstract). These are not a feature of the instant invention. The

instant invention requires a complete ***fiber image*** and the ***serial number*** encrypted in the barcode in order to authenticate the genuineness of the product in question. Note that vector mapping or statistical tolerance of the medium is subject to statistical errors, whereas in the instant invention, the complete image for identifying the genuineness of the product. Since the purpose of the instant invention is to prevent forgery, representation of a product identification, a complete fiber image helps in preventing forgery.

(C) Although Kerns et al. discloses printing of barcode onto an article or an label via an algorithm, it does not suggest, teach, or motivate the invention recited in the newly drafted independent claim 21. Although Kerns et al. discloses the use of serial number in the barcode, the combination of Kaish et al. and Kerns et al. do not suggest, teach or motivate that the planer code is adapted for storing ***information of the fiber image*** of the fiber texture sector, and the ***serial number*** of the object by using a first pre-set algorithm, wherein the fiber texture sector and the planer bar code sector form a ***unique anti-forgery representation and a product identification*** of the product so as to maximize a difficulty in unauthorized reproduction of the encrypted texture label. In other words, potential infringers need to forge both the product identification serial number and the fiber image intermingled with each other to successfully forge the product in question. This substantially increases the difficulty of forging the product which bears the encrypted textual label of the instant invention.

(D) A potential infringer may need to obtain both the information about product identification and information of the fiber image in order to forge the product in question. This makes forging of the product or the encrypted texture label much more difficult.

(E) The Examiner appears to reason that since Kerns et al. teaches that two serial number can be stored in a two dimensional barcode, it would have been obvious to one skilled in the art to combine Kerns et al. with Kaish et al. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the

question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In the present case, there is no such suggestion.

(F) The Court of Appeal of the Federal Circuit has stated, "[V]irtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983). Thus, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ 2d 1600 (Fed. Cir. 1988). The obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Moreover, the Federal Circuit in *In re Dembiczak*, 175 F.3rd 994, 50 USPQ2d 1614 (Fed. Cir. 1987) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific....findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis". The unexpected result entailed from the instant invention does not anticipated by Kaish et al. and Kerns et al.

7. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

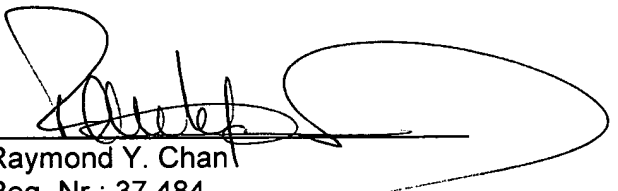
The Cited but Non-Applied References

8. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

9. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 21-32 at an early date is solicited.

10. Should the examiner believes that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

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